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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,583	10/30/2003	William J. Farrell JR.	548A.0001	7235
25534	7590	01/21/2010	EXAMINER	
CAHN & SAMUELS LLP			GILBERT, WILLIAM V	
1100 17th STREET NW			ART UNIT	PAPER NUMBER
SUITE 401			3635	
WASHINGTON, DC 20036			MAIL DATE	
			01/21/2010	
			DELIVERY MODE	
			PAPER	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/696,583
Filing Date: October 30, 2003
Appellant(s): FARRELL ET AL.

William E. Bradley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04 November 2009
appealing from the Office action mailed 04 March 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of Appendix B on page 23 of the Appendix to the appellant's brief. The minor errors are as follows: Applicant relies on the following evidence in the appeal brief, but did not provide a list, nor when this evidence was considered by the examiner. The list is as follows:

Declaration of Mark D. Heath, including a resume, filed 11 December 2008 and considered by the examiner on 04 March 2009.

Declaration of William J. Farrell, Jr., filed 11 December 2008 and considered by the examiner on 04 March 2009.

(8) Evidence Relied Upon

4,611,450	CHEN	9-1986
1,644,837	STRAND	4-1928
6,272,805	RITTER	8-2001
6,820,387	SACKS	11-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent No. 4,611,450) in view of Strand (U.S. Patent No. 1,664,837) and Ritter (U.S. Patent No. 6,272,805).

Claim 22: Chen discloses a construction panel comprising outer and inner wire mesh members (Fig. 2-3: 223), a middle member (10, 14, 16 and 30) comprising a plurality of layers comprising wire trusses and polystyrene foam (abstract, line 11), disposed between the outer and inner mesh members and positioned to define a first gap (see, e.g. Fig. 2-3: 231) between the middle member (portions 10, 14 and 16) and the outer mesh members and a second gap (Fig. 2-3: 231) between the middle member and inner mesh, the middle member is connected to the inner and outer mesh members by attaching the mesh to the trusses on outside ends of said middle member (see Fig. 2-3, the apex of the truss, proximate 232), and an outer layer of a

cement material (claim 8) on the members. While Chen discloses a mesh member (223), it does not disclose screed ridges with an impression having an apex projecting outwardly from the member. Strand discloses a mesh screed member (Fig. 1: 15 and 18) and having outwardly pointing apices (see "A" from attached Fig. 2 from Strand below). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mesh in Strand with the mesh in Chen because the mesh in Strand would perform equally as well as the mesh in Chen and would add a further dimension to aid in the bonding of the cementitious material to the mesh. Last, while the prior art of record discloses a cement material is a coating on the panel that extends to the apex of the mesh (see e.g. Strand Fig. 2), it does not disclose that the material is concrete. Ritter discloses a construction element with a foam core and concrete outer layers (see Fig. 16a: 13'). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a concrete coating because as disclosed in Chen (claim 8) numerous cement based materials may be used, and concrete is a cement based material and would perform equally as well depending on the desired effect of the outer layer of the panel.

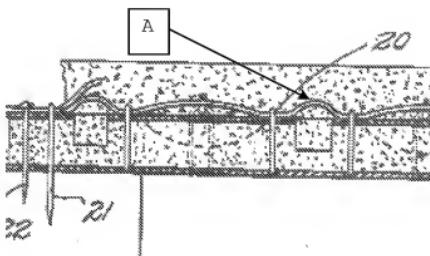


Figure 2 from Strand

Claim 23: as shown in the obvious combination of the prior art, the screed ridges extend the entire length of the mesh members from a top end to a bottom end (see Strand Fig. 1, generally).

Claims 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Strand, Ritter and Sacks (U.S. Patent No. 6,820,387).

Claim 24: the prior art of record discloses the claimed invention including a ridge as claimed, but not that the ridge is V-shaped. Sacks discloses a screed member (Fig. 2) with a V-shaped ridge (proximate 15: please note that only the shape of the ridge is considered). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation

because a configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04. A V-shaped screed would result in a properly operating member that would function in the same manner as the screed in the prior art cited.

Claims 25-27 and 35: While the combination of the prior art cited discloses three ridges (see Strand, generally), it does not disclose the dimensions as claimed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions of the ridges and panels as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV)(A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was

not patentably distinct from the prior art device. Further, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have this limitation because optimization of an invention will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such a limitation is critical. See M.P.E.P. §2144.05 "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100C and an acid concentration 10%.)

Claims 28 and 32: Chen discloses a construction panel comprising an outer and inner wire mesh members (Fig. 2-3: 223), a middle member (10, 14, 16 and 30) comprising a plurality of layers comprising wire trusses and polystyrene foam (abstract, line 11), disposed between the outer and inner mesh members and positioned to define a first gap (see, e.g. Fig. 2-3: 231) between the middle member (portions 10, 14 and 16) and the outer mesh members, and a second gap (Fig. 2-3: 231) between the

middle member and inner mesh, the middle member is connected to the inner and outer mesh members by attaching the mesh to the trusses on outside ends of said middle member (see Fig. 2-3, the apex of the truss, proximate 232) and an outer layer of a cement material (claim 8) on the members. While Chen discloses a mesh member (223), it does not disclose screed ridges with an impression having an apex projecting outwardly from the member. Strand discloses a mesh screed member (Fig. 1: 15 and 18) having three outwardly pointing apices (see "A" from attached Fig. 2 from Strand above). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to sue the mesh in Strand with the mesh in Chen because the mesh in Strand would perform equally as well as the mesh in Chen and would add a further dimension to aid in the bonding of the cementitious material to the mesh. Further, while the prior art of record discloses a cement material is a coating on the panel that extends to the apex of the mesh (see e.g. Strand Fig. 2), it does not disclose that the material is concrete. Ritter discloses a construction element with a foam core and concrete outer layers (see Fig. 16a: 13'). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a concrete coating because as disclosed in Chen (claim 8) numerous cement based materials may be used,

and concrete is a cement based material and would perform equally as well depending on the desired effect of the outer layer of the panel. In addition, the dimensions of the apex of the ridges would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Last, the prior art of record discloses a ridge as claimed, but not that the ridge is V-shaped. Sacks discloses a screed member (Fig. 2) with a V-shaped ridge (proximate 15: please note that only the shape of the ridge is considered). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation because a configuration of an invention is a matter

of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04. A V-shaped member would still operate properly as a screed and would not depart from the concept of the prior art cited.

Claims 29 and 33: the middle member comprises a plurality of layers comprising wire trusses (Chen: 211) and polystyrene (212) between the wire mesh members and defining a gap between the middle member and the wire mesh members (see Chen: Fig. 1).

Claims 30 and 34: the middle member (Chen: portion 30) is connected to the mesh member by attaching the mesh member to trusses on outside ends of the middle member (see Fig. 1: proximate 32, which is an outside end of the middle member, as it is attached to the mesh.

Claim 31: the prior art of record discloses the claimed invention except for the dimensions of the member as claimed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being

designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

(10) Response to Argument

The examiner did not err in the rejection of claims 22 and 23 under 35 USC §103(a) as being unpatentable over Chen in view of Strand and Ritter.

The issue is whether the prior art meets the claim language "screed ridge" (brief: page 8). Applicant cites excerpts from paragraphs [0007], [0052], [0053] and [0059] to support his position that the prior art does not meet, or renders obvious, the claimed invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of the screed as provided in the disclosure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the above cited disclosure, and in applicant's brief, applicant respectfully does not provide the limitations of the use of the screed. For example, in paragraph [0053] of applicant's disclosure, applicant stresses the use of the apexes of the "V-shaped" impressions, in particular that, "the panel can be cut with a screed blade running along the apexes of the V-shaped impressions." See brief: page 8. Applicant respectfully does not provide this limitation in any of the claims. Applicant, rather argues the intended use of the invention, which is discussed in greater depth below. As a result, the examiner considers the obvious combination of the prior art above as proper, and the rejection should respectfully be sustained.

Applicant further argues that the combination of Chen in view of Strand is improper because the examiner's rationale for combining the prior art is different from applicant's claimed invention (brief: page 9). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. &

Inter. 1985). The examiner incorporated the ridges in Strand with the system in Chen in order to aid in the bonding of the cementitious material to the mesh (see the rejection above). It is well known that irregular shapes (such as ridges) as presented in the mesh in Strand aid in bonding of the material to the mesh. While this serves a different purpose, the structural limitations are met through the combination of the prior art. The examiner's reasoning for combining the references is well within the level of skill in the art, and the reasoning satisfies the requirements as provided in *Obiaya*. The examiner maintains the rejection is proper.

Regarding the declaration of Mark Heath (brief: page 10; see also Evidence Appendix B), the examiner respectfully disagrees with the position of Mr. Heath. The examiner maintains the same position as noted above in that Mr. Heath's arguments are also drawn to limitations not presented in the claims. The declaration attempts to discredit the combination of the prior art by arguing that the intended use of the claimed invention is different than the combination of the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (citing *In re Schreiber*, 128 F.3d 1473,

1477-78 (Fed. Cir. 1997)). Further, “[A]pparatus claims cover what a device *is*, and not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990) (emphasis in original). See MPEP §1224. Based on the case law presented above, the function of the claimed invention does not distinguish from the prior art because the structure is present in the combination of the prior art.

Regarding the declaration of Mr. Farrell (brief: page 13), the evidence presented does not provide persuasive evidence that the commercial success is the result of the claimed invention. First, as stated in the Office action dated 04 March 2009, objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of

commercial success was not commensurate in scope with the broad claims at issue.) The limitations that applicant argues, (the dimensions, quantity and location of the ridges, etc.) are drawn to the more narrow dependent claim and not the broad claims at issue. Further, in considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. (citing *In re Mageli*, 470 F.2d 1380 (CCPA 1973)). See MPEP §713.03(a). Aside from the fact that the show of success is not commensurate with the claims, applicant has not provided any evidence to show that the commercial success was achieved in the above noted manner. "Merely showing that there was commercial success of an article which embodied the invention is not sufficient." *Ex. Parte Remark*, 15 USPQ 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). See MPEP §716.03(b)(I). Without proper evidence provided, the declaration is not persuasive, and the rejection is proper.

The examiner did not err in the rejection of claims 24-35 under 35 USC §103(a) as being unpatentable over Chen in view of Strand, Ritter and Sacks.

The issue is whether the combination of the prior art above is obvious to one having ordinary skill in the art at the time the invention was made. Applicant claims that the ridges are to be "V-shaped" (e.g., Claim 24, line 2). The examiner cited Strand to show that ridges (as shown in "A" from attached Fig. 2 from Strand above) are obvious in such systems. Strand arguably did not disclose the shape of the ridges were "V-shaped" as claimed, so the examiner incorporated Sacks to show that it is within the level of skill in the art to have ridges in the shape of a "V". The examiner does not contest the orientation of the ridge. The examiner, however, respectfully notes that it was the shape of the ridge, not the orientation of the ridge that was used in the rejection (see e.g., rejection of claim 24 above). A configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04. The examiner holds the position that the shape of the ridge in Strand, and the shape of the ridge in Sacks are

similar, and make the minimal change of shape from what is arguably a "U-shaped" ridge in Strand to a "V-shaped" ridge in Sacks would be well within the level of skill in the art. The examiner maintains that the obvious shape change would not result in any functional difference in the combination of the prior art, the combination is obvious and the rejection is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William V Gilbert/

Examiner, Art Unit 3635

Conferees:

/Heather Shackelford/

Conferee

/Basil Katcheves/

Primary Examiner, Art Unit 3635